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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922.818	08/06/2001	Eun Sam Kim	2080-3-31	8857

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EXAMINER

SHIBRU, HELEN

ART UNIT                      PAPER NUMBER

2621

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01/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

<b>Application No.</b> 09/922,818	<b>Applicant(s)</b> KIM, EUN SAM	
<b>Examiner</b> HELEN SHIBRU	<b>Art Unit</b> 2621	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 December 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1.  The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
- a)  The period for reply expires 3 months from the mailing date of the final rejection.
- b)  The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2.  The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3.  The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a)  They raise new issues that would require further consideration and/or search (see NOTE below);
- (b)  They raise the issue of new matter (see NOTE below);
- (c)  They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d)  They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4.  The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5.  Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6.  Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7.  For purposes of appeal, the proposed amendment(s): a)  will not be entered, or b)  will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: \_\_\_\_\_.
- Claim(s) rejected: 1-24.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8.  The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9.  The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10.  The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11.  The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Cont. Sheet below.
12.  Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_
13.  Other: \_\_\_\_\_.

Continuation of 3. Applicant stated the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application and cited *Hyatt v. Boone*, 146 F.3d 1348, 1352, 47 USPQ2d 1128, 1130 (Fed. Cir. 1998). In response the Examiner respectfully disagrees. First of all, the court case and the cited part of a section in MPEP discusses interferences not 1.131. However Applicant is not discussing an interferences.

Second, the filing of a Korean patent application is not a constructive reduction to practice. Only the filing of a US application is a constructive reduction to practice. When using 1.131, the filing of the involved US application is considered a constructive reduction to practice. The declaration under 1.131 would attempt to show:

- (A) (actual) reduction to practice of the invention prior to the effective date of the reference; or
- (B) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to a subsequent (actual) reduction to practice; or
- (C) conception of the invention prior to the effective date of the reference coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).


Note that in (C), the constructive reduction to practice indicated is the US application being examined.

Furthermore, even if this were an interference, constructive reduction to practice means the same thing: the filing of a US patent application. Here is the complete quote from the *Hyatt v. Boone* case that is cited in MPEP 2138.05:

"The filing of a patent application serves as conception and constructive reduction to practice of the subject matter described in the application. *Yasuko Kawai v. Metlesics*, 480 F.2d 880, 885, 178 USPQ 158, 162 (CCPA 1973) (" [T]he act of filing the United States application has the legal effect of being, constructively at least, a simultaneous conception and reduction to practice of the invention."); see *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376, 231 USPQ 81, 87 (Fed.Cir. 1986) ("constructive reduction to practice occurs when a patent application on the claimed invention is filed"); *In re Glass*, 492 F.2d 1228, 1232, 181 USPQ 31, 34 (CCPA 1974). There is no need for proof or corroboration of the subject matter that is included in the application unless a date earlier than the filing date is sought to be established. *Yasuko Kawai*, 480 F.2d at 886, 178 USPQ at 163 ("the written specification in the application is the evidence proving the invention of that which is reduced to practice"). Thus the inventor need not provide evidence of either conception or actual reduction to practice when relying on the content of the patent application.

The Applicant is trying to convince the Examiner by saying that filing a foreign patent application is a constructive reduction to practice when the case is actually stating that a US application has the legal effect of being a constructive reduction to practice. If the Korean application had been filed such that 119(a)-(d) priority could have been claimed, the effect is only to move the date for the constructive reduction to practice resulting from the filling of the US application back to the date of the filling of the Korean application.

Therefore, the Korean application shows only conception for the the subject matter disclose in the present application. There still has to be an actual reduction to practice prior to the reference 102(e), or diligence from a time immediately prior to the 102(e) date through a reduction to practice (actual or constructive) after 102(e) date.

  
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